



Ifu

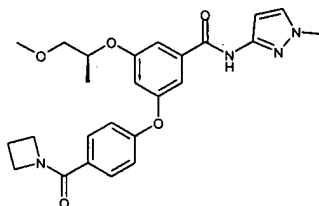
PATENT
Attorney Docket 056291-5298

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Craig Johnstone et al.)	Confirmation No. 7217
)	
Application No. 10/588,334)	Group Art Unit: 1617
)	
Filed: August 3, 2006)	Examiner: Paul E. Zarek
)	
For: Benzamide Derivatives and Their)	Date: December 5, 2008
Use as Glucokinase Activating)	
Agents)	

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement, Applicants elect with traverse the invention of Group III (claims 18-32), wherein HET-1 is a diazole. As to the species election, Applicants elect with traverse the compound of Example 3b



wherein HET-1 is a pyrazole; R^1 is methoxymethyl; n is 0; m is 1; R^2 is $-C(O)-\text{HET-3}$; and HET-3 is an azetidine ring. Claims 22-25 and 30-32 read on the elected species.

The traversal is on the ground that the inventions share a special technical feature that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. The Restriction Requirement and the Election of Species Requirement allege that Compound II-100 of Boyd *et al.* (WO 03/015774) renders the claimed invention obvious because Compound II-100 differs from the claimed invention only at position R^1 , which is a 1-methylethyl for Compound II-100 and a methoxymethyl for the claimed inventions. However, Applicants respectfully point out that the compounds of the present invention and the compounds of Boyd *et al.* have a further difference. The compounds of the present invention have a direct phenoxy substituent and an alkyl ether linked to the central phenyl ring. In contrast, Boyd *et al.* do not disclose compounds having a phenoxy substituent and an alkyl ether

linked to the central phenyl ring. Given the combined differences between the compounds, the compounds of Boyd *et al.* do not render the claimed invention obvious. Accordingly, the claimed inventions share a special technical feature that define a contribution over the prior art and are linked to form a single general inventive concept. Thus claims 18-35 and all the compounds encompassed by the claims should be searched and examined together in one application.

Also, under 37 CFR 1.475(b)(3), claims drawn to different categories of invention will have unity of invention if drawn to a combination of the following categories: a product, a process of making the product, and a method of using the product. Claims 18-35 as they stand are drawn to this combination of categories of invention and should be examined together.

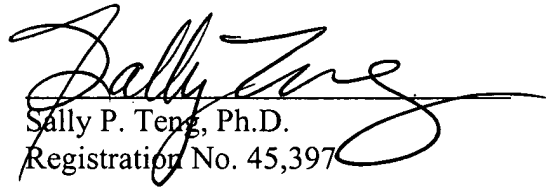
Moreover, claims 33-35 are directed to methods of using and making the compounds of Inventions I-V. Applicants respectfully point out that MPEP 821.04(b) requires that once a product claim is found allowable, withdrawn method claims which depend from or otherwise include all the limitations of the allowable product claim must be rejoined. Thus, at a minimum, once a claim directed to a compound (claims 18-32) is found allowable, withdrawn method claims (claims 33, 34, and 35) which depend from or otherwise include all the limitations of the allowed claim must be rejoined.

Furthermore, it is Applicants' understanding that the election of the single compound is a species election. It is also Applicants' understanding that the Examiner intends to begin by searching the elected species and will continue searching until art is found or until a generic claim (directed to the molecular core ring structure) is found allowable. Moreover, Applicants point out that when a generic claim is found to be allowable, the withdrawn claims which depend from or include the limitations of the allowed claim must be rejoined and fully examined for patentability. MPEP 809.

If there are any fees due in connection with the filing of this response to the Restriction Requirement, please charge the fees to our Deposit Account No. 50-310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: **December 5, 2008**
Morgan, Lewis & Bockius LLP
Customer No. **09629**
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
202-739-3000

Respectfully submitted,
Morgan, Lewis & Bockius LLP


Sally P. Teng, Ph.D.
Registration No. 45,397